

REMARKS

1. Restriction Requirement

The Office Action mailed July 16, 2004 (“the Office Action”) requires restriction to one of three identified groups:

- I. Claims 1 – 7;
- II. Claims 8 – 11; and
- III. Claims 12 – 22.

The provisional election of Group I with traverse is affirmed. The election is made with traverse in part because claims cannot properly be restricted without a showing that a search and examination of the claims on the merits would constitute an undue burden on the Office, even when the claims are directed to independent and distinct inventions. MPEP 803.01. In establishing the existence of an undue burden, the Office must demonstrate that examination of the claims would involve substantially different prior-art searches that renders coexamination unduly burdensome. To do this, the Office must demonstrate that the restricted groups have a separate classification, have a separate status in the art, or that searching would require a search of different fields. MPEP 808.02.

In this instance, the claims of Groups I and II are classified in the same class, but in different subclasses. It is noted, however, that the classification of the claims of Group II appears incorrect. Both groups of claims define methods “for processing a transaction with a customer at a point of sale.” While class 705, subclass 17 appears to be an appropriate classification for both groups, it is noted that the classification of class 705, subclass 53 for Group II is identified as “Business processing using cryptography / Usage protection of distributed data files / Usage or charge determination / Including third party for collecting or distributing payment (e.g., clearinghouse).” This classification appears to include aspects that are not recited in the claims of Group II.

Even if the classification of the claims of Group II is correct, that there would be no undue burden to examine those claims concurrently with the claims of Group I is evident from the content of the claims. In particular, the first two elements of Claim 8 recite limitations that appear in Claim 1 and the last two elements of Claim 8 parallel closely the limitations of Claim 7. Similarly, the additional limitation of Claim 9 appears in Claim 1 and the limitations of Claims 10 and 11 are respectively similar to the limitations of Claims 3 and 4. The close similarity of issues involved in the claims of Groups I and II means that a search for art in one group would be substantially coextensive with a search for art in the other group. For this reason, it would not be an undue burden to examine the claims in both groups.

The restriction between Groups I and III and between Groups II and III is also traversed as improper pursuant to MPEP sections 806.05(e) in light of the U.S. Patent and Trademark Office's published Examination Guidelines for Computer-Related Inventions ("EGCRI"). In MPEP § 806.05(e) it states that "[i]n applications claiming inventions in different statutory categories, only one-way distinctiveness is generally needed to support a restriction requirement." Specifically, invention distinctiveness for a process and an apparatus for its practice requires a showing "(1) that the process *as claimed* can be practiced by another materially different apparatus or by hand, or (2) that the apparatus *as claimed* can be used to practice another materially different process." (*Id.*, emphasis in original). In the absence of such distinctiveness, a restriction requirement between claims directed to a process and an apparatus for its practice is improper. With respect to computer-related inventions, EGCRI §IV.B.2.(a)(i) clarifies that when an apparatus claim encompasses "*any and every* computer implementation of a process, when read in light of the specification, the claim should be examined on the basis of the underlying process" (emphasis in original). That section continues with an example of how to recognize such an apparatus claim. It will:

- define the physical characteristics of a computer or computer component exclusively as functions or steps to be performed on or by a computer, and
- encompass *any and every* product in the state class (e.g., computer, computer-readable memory) *configured in any manner* to perform that process. (*Id.*)

In the instant application, the claims included in Group III define physical characteristics of computer components as functions performed by a computer to implement the methods of the claims of Group I (Claims 12 – 18) and of Group II (Claims 19 – 22). In addition, the specification does not include specific software, i.e., programming code recited to define those functions. Thus, the computer-readable storage medium defined by the claims included in Group III encompasses any and every product in the class configured in any manner to perform the methods defined by claims included in Groups I and II. As a result, the claims included in Group III should be rejoined with the claims of Groups I and II as they necessarily stand or fall together, i.e., the patentability of the apparatus claims in Group III hinges on the patentability of method claims in Groups I and II. It was therefore improper to restrict the claims of Group III from the claims of Groups I and II, and they should be rejoined.

The restriction is also traversed based on the fact that certain of the claims are linking claims. To summarize the relevant law, “[t]here are a number of situations . . . in which an application has claims to two or more properly divisible inventions, so that a requirement to restrict the application to one would be proper, but presented in the same case are one or more claims (generically called “linking” claims) *inseparable therefrom* and thus linking together the inventions otherwise divisible.” (MPEP § 809.03)(emphasis added). A common type of linking claim includes means for practicing a process linking proper apparatus and process claims. (*Id.*).

In the present case, Claim 12 defines an apparatus for performing the steps of the method recited in Claim 1. Similarly, Claim 19 defines an apparatus for performing the steps of the method recited in Claim 8. As such, they are all linking claims and it is improper to restrict the claims of the different groups from them. Should the linking claims be deemed allowable, then the restriction requirement would be improper and the requirement restricting the claims of the three groups would need to be withdrawn (See MPEP 818.03(d)). Since each of apparatus claims in Group III is thus linked with the method claims of Group I or of Group II, the claims of Group III would not be divisible from those of Group I or Group II were the linking claims found to be allowable.

2. Claim Rejections

Claims 1 – 7 have been examined and are understood to stand rejected under 35 U.S.C. §103(a) as unpatentable over U.S. Pat. No. 6,631,849 (“Blossom”) in view of U.S. Pat. No. 5,930,764 (“Melchione”).¹ The rejections are respectfully traversed.

First, neither of the cited references discloses the claim limitation of Claim 1 requiring “generating a request to select a distribution of the cost for the transaction among the stored-value and credit accounts for presentation at the point-of-sale device.” The Office Action relies on Blossom for this limitation, but while Blossom discloses a card that may be used for different types of transactions (Blossom, Col. 2, ll. 47 – 49), it never discloses or suggests distributing the cost of a transaction among multiple accounts. The lack of such a disclosure suggests that while the card described in Blossom has “features [that] may allow the card to function as a different card, such as a credit card, debit card, ATM bank card, stored value card, security card identity card, and the like” (*id.*, Col. 3, ll. 16 – 18), only one such functionality is used for any particular transaction. If the Office continues to rely on Blossom for this limitation, Applicant requests a specific identification of what part of Blossom is relied on as disclosing “a distribution of the cost for the transaction among the stored-value and credit accounts” (emphasis added). 37 C.F.R. §1.104(c)(2).

Second, neither of the cited references discloses the claim limitation of Claim 1 requiring that “the stored-value account and the credit account were linked substantially contemporaneously with issuance of the instrument to the customer.” The Office Action acknowledges that Blossom does not disclose this limitation, relying on Melchione for this limitation (Office Action, p. 3). Melchione is a lengthy document and the Office Action does not cite any particular portion of the document other than to remark that “Melchione et al. do disclose such a feature wherein the system ‘in a single session’ links an account with plural sources” (*id.*, p. 3). References to “in a single session” occur a number of times in Melchione in describing the opening of an account but never couples such a description with linking separate

¹ The Office Action appears to have inadvertently omitted language stating the full basis for rejection on p. 2.

accounts substantially contemporaneously with issuance of an instrument that is associated with the accounts. For example, Melchione discloses:

Another important aspect of the present invention is interface of the electron sales and service support system and process with a system and method for opening a single account that includes a full range of financial components. Thus the integrated system of the present invention also preferably includes a system 17 for opening an account, preferably in a single session. The system is preferably in communication with the central database, micromarketing centers, central customer information systems and branch systems of the present invention so that data can pass between these systems where legal and appropriate.

In its preferred form, the system 17 and process one-step account or relationship opening includes several steps or stages. These are: account selection, needs assessment, building a personal profile, building the customer account, selecting customer services, enrolling the customer in remote access services, printing an enrollment form, issuing a bankcard, determining the identity and number of persons having access to an account and finally, suitable follow-ups. (Melchione, Col. 43, ll. 33 – 52).

Thus, the description of the account setup, even if the identified parts of that process are performed in a single session, does not meet the claim limitation requiring that “the stored-value account and the credit account were linked substantially contemporaneously with issuance of the instrument to the customer.” Some additional discussion is provide in Melchione of linking accounts at Col. 36, ll. 5 – 42, but this discussion relates to linking the accounts in order to display household/customer financial summary screens. That additional discussion also has no disclosure of a stored-value account and credit account being linked substantially contemporaneously with issuance of an instrument associated with both accounts. If the Office continues to rely on Melchione for this limitation, Applicant requests a specific identification of what part of Melchione is relied on as disclosing that “the stored-value account and the credit account were linked substantially contemporaneously with issuance of [an] instrument.” 37 C.F.R. §1.104(c)(2).

In connection with Claims 6 and 7, the Office Action states that “the step of applying only what is available in either credit or value to a cost and/or splitting same between them is deemed an old an[d] obvious expedient” (Office Action, p. 4). Applicant disagrees with such a characterization; if the statement is intended to rely on Official Notice, such taking of Official Notice is respectfully traversed and documentary evidence is requested. MPEP 2144.03.

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PATENT

It is respectfully believed that "deeming" the specifically recited claim limitations as old and obvious fails to provide a sufficient technical line of reasoning underlying a decision to take Official Notice as required under MPEP 2144.03.

CONCLUSION

In view of the foregoing, Applicants believe all claims now pending in this Application are in condition for allowance. The issuance of a formal Notice of Allowance at an early date is respectfully requested.

If the Examiner believes a telephone conference would expedite prosecution of this application, please telephone the undersigned at 303-571-4000.

Respectfully submitted,

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